

REMARKS

Claims 14-22, 24 and 25 are pending. Claim 14 has been amended for clarity. No new matter has been added by way of the above-amendment.

Issues Under 35 U.S.C. 103(a)

The Examiner has imposed a new rejection of claims 14-22 and 24-25 under 35 U.S.C. 103(a) as being obvious over JP 2003-004526 (JP '526). Applicants respectfully traverse the rejection.

The present invention is directed, *inter alia*, to a laminate, comprising a polymer substrate in which a cyclized rubber is incorporated into a polymer-molding material made of a non-polar hydrocarbon resin, and a thin film laminated on the surface of the polymer substrate by a dry film-forming process (see, e.g., claim 14). As discussed at paragraphs (0002)-(0003) of the present Specification (paragraph numbers refer to US 2006/0127655 which is the publication of the present application), during conventional film-forming processes, issues arise with regards to the adhesiveness of the obtained thin film, which is poor. This is caused when a polymer substrate made of a non-polar hydrocarbon polymer substrate is subjected to a dry film-forming process. In order to solve the problems of prior art film-forming processes, the present inventors have discovered a method of improving the adhesiveness of a thin film, wherein a conjugated diene polymer cyclized product or a derivative thereof is incorporated into a non-polar hydrocarbon resin (see also paragraph (0013) of the Specification).

These advantages are neither taught nor suggested by JP '526.

Applicants have carefully reviewed the Examiner's comments in the outstanding Office Action and note that the Examiner has made several assumptions regarding the obviousness of the present invention.

As noted above, claims 14 and 25 require that the non-polar hydrocarbon resin is mixed with the conjugated diene polymer cyclized product or a derivative thereof to form the polymer substrate. The Examiner appears to be relying on the English translation of paragraph [0029] wherein JP '526 teaches a transparent resin molded product 1 is coated with an adhesive layer 8. Specifically, the Examiner notes that panel 1 can be made of polypropylene which the Examiner

equates with the inventive non-polar hydrocarbon resin. Also, the Examiner notes that the adhesive layer 8 of JP '526 can be made of a cyclized rubber.

The Examiner is aware that JP '526 teaches that the polypropylene is in a separate layer from the cyclized rubber. However, the Examiner states:

[I]t is well established in the art that adhesive materials or adhesion promoting materials may be incorporated into the polymer substrate as opposed to, or in addition to, providing a separate layer of the adhesive material. (See page 2, lines 14-17 of the outstanding Office Action.)

Here, it appears that the Examiner has taken "Official Notice" that adhesive materials or adhesion promoting materials may be incorporated into the polymer substrate. The Examiner's "Official Notice" is unsupported by documentary evidence. Please note that an Examiner can only use "Official Notice" in a very limited set of situations. According to MPEP 2144.03,

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. (Emphasis added).

In view of the fact that the Examiner's assumption is not common knowledge in the art capable of instant and unquestionable demonstration, Applicants request that the Examiner provides documentary evidence to support her position. Applicants respectfully submit that the Examiner has made a leap in logic that the ordinary artisan would not have made, i.e., to take a layer made of polypropylene and combine it with another adhesive layer made of cyclized rubber to form a single layer.

Furthermore, although JP '526 discloses a laminate comprising a transparent resin molded product, an adhesive layer, and a deposition layer laminated in this order, it is completely silent regarding the transparent resin molded product comprising a cyclized rubber.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d

488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Applicants respectfully submit that a *prima facie* case of obviousness cannot be said to exist, since there is no reason for the artisan to do what is now claimed. That is, it would not be obvious to take a layer made of polypropylene and combine it with another adhesive layer made of cyclized rubber to form a single layer, as asserted by the Examiner and it would not be obvious to make a transparent resin molded product comprising a cyclized rubber.

Reconsideration and withdrawal of the rejection are respectfully requested.


In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Reg. No. 43,575 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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